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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,044	01/18/2004	Mitchell M. Rohde	1048.004US1	8490
23441 7590 06/04/2007 LAW OFFICES OF MICHAEL DRYJA 704 228TH AVENUE NE PMB 694 SAMMAMISH, WA 98074			EXAMINER HU, KANG	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,044

Applicant(s)

ROHDE ET AL.

Examiner

Kang Hu

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1, lines 4 states “plurality of predetermined people other than the customer”, it is unclear to the examiner how the customer can be excluded from the predetermined people in the database in view of the specification.

Claims 2-7 are rejected because they are dependent upon claim 1.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3714

3. Claims 1-8 and 10-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Howard et al. (US 2004/0133582 A1).

Re claim 1, Howard discloses a method comprising: detecting biometric information of the customer by an entertainment machine can be interpreted as a computer; the entertainment machine comparing the biometric information of the customer against a database of biometric information of a plurality of predetermined people other than the customer and with which the customer is likely to be familiar to yield one or more people having biometric information that most closely matches the biometric information of the customer (comparing a sketch drawing by the player against the database); and, indicating to the customer by the entertainment machine of identities of the one or more people having biometric information that most closely matches the biometric information of the customer (abstract; figs 4, 5, 8 and 9; ¶ 26, 97, 98, 125, 143-145, 148 and 149).

Howard further teaches:

Re claim 2. The method of claim 1, wherein detecting the biometric information of the customer comprises acquiring one or more of: facial images of the customer; voice samples of the customer; fingerprint scans of the customer; handprint scans of the customer; and, retinal eye scans of the customer (¶ 19-20).

Re claim 3. The method of claim 1, wherein comparing the biometric information of the customer against the database of biometric information of the plurality of predetermined people

Art Unit: 3714

other than the customer comprises comparing the biometric information of the customer against one or more databases selected from a database of biometric information of a plurality of famous individuals; a database of biometric information of a plurality of sports stars; a database of biometric information of a plurality of celebrities; a database of biometric information of a plurality of politicians; a database of biometric information of a plurality of historical figures, and, a database of biometric information of a plurality of fictitious characters (§ 147-149).

Re claim 4. The method of claim 1, wherein comparing the biometric information of the customer against the database of biometric information of the plurality of predetermined people other than the customer comprises yielding a predetermined number of the one or more people having biometric information that most closely matches the biometric information of the customer (§ 143-145).

Re claim 5. The method of claim 1, wherein comparing the biometric information of the customer against the database of biometric information of the plurality of predetermined people other than the customer comprises yielding the one or more people having biometric information that most closely matches the biometric information of the customer as the one or more people having biometric information that matches the biometric information of the customer by more than a threshold (§ 143-149).

Re claim 6. The method of claim 1, wherein indicating to the customer by the entertainment machine of the identities of the one or more people having biometric information that most

Art Unit: 3714

closely matches the biometric information of the customer comprises displaying at least one of a picture and a name of each of the one or more people (§ 19-21).

Re claim 7. The method of claim 1, wherein indicating to the customer by the entertainment machine of the identities of the one or more people having biometric information that most closely matches the biometric information of the customer comprises printing a hardcopy of at least one of a picture and a name of each of the one or more people (§ 112).

Re claim 8. An entertainment machine comprising: a biometric acquisition mechanism to obtain biometric information of a customer; a computer-readable medium having stored thereon a database of biometric information of a plurality of predetermined people with which the customer is likely to be familiar (abstract, § 19-21, 147-149); a comparison mechanism to compare the biometric information of the customer against the database to yield one or more people having biometric information that most closely matches the biometric information of the customer (§ 143-145); and, an output mechanism to indicate to the customer the one or more people having biometric information that most closely matches the biometric information of the customer (§ 112).

Re claim 10. The entertainment machine of claim 8, wherein the biometric acquisition mechanism comprises one or more of: an image-capturing mechanism to capture at least one of facial images, retinal scans, and eye scans of the customer; a sound-recording mechanism to

Art Unit: 3714

record voice samples of the customer; and, a touch-sensitive mechanism to obtain at least one of fingerprint scans and handprint scans of the customer (§ 12 and 13).

Re claim 11. The entertainment machine of claim 8, wherein the database comprises one or more of: a database of biometric information of a plurality of famous individuals; a database of biometric information of a plurality of sports stars; a database of biometric information of a plurality of celebrities; a database of biometric information of a plurality of politicians; a database of biometric information of a plurality of historical figure; and, a database of biometric information of a plurality of fictitious characters (§ 147-149).

Re claim 12. The entertainment machine of claim 8, wherein the output mechanism comprises at least one of: a display device, and a printing device (§ 112).

Re claim 13. A method comprising: detecting biometric information of a first customer by an entertainment machine; detecting biometric information of a second customer different than the first customer by the entertainment machine; determining how closely the biometric information of the first customer and the biometric information of the second customer match; and, indicating how closely the biometric information of the first customer and the biometric information of the second customer match to the first and the second customers by the entertainment machine (fig 4, 5; § 22-23, 125 and 127).

Art Unit: 3714

Re claim 14. The method of claim 13, wherein detecting the biometric information comprises acquiring one or more of: facial images; voice samples; fingerprint scans; handprint scans; and, retinal scans (fig 1; ¶100, 105).

Re claim 15. The method of claim 13, wherein determining how closely the biometric information of the first customer and the biometric information of the second customer match comprises determining a similarity value between the biometric information of the first customer and the biometric information of the second customer (¶ 125 and 126)

Re claim 16. The method of claim 15, wherein indicating how closely the biometric information of the first customer and the biometric information of the second customer match to the first and the second customers comprises displaying the similarity value (¶22, 23, 102, 125 and 126).

Re claim 17. The method of claim 15, wherein indicating how closely the biometric information of the first customer and the biometric information of the second customer match to the first and the second customers comprises printing a hardcopy of the similarity value (fig 4).

Re claim 18. An entertainment machine comprising: a biometric acquisition mechanism to obtain biometric information of a first customer and biometric information of a second customer different than the first customer; a comparison mechanism to determine how closely the biometric information of the first customer matches the biometric information of the second customer; and, an output mechanism to indicate to the first customer and the second customer

how closely the biometric information of the first customer matches the biometric information of the second customer (§ 125 - 127).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (2004/0133582 A1) in view of Walker et al. (6,110,041). The teachings of Howard have been discussed above. However Howard does not teach of a credit-accepting mechanism to accept cash-oriented credit from the customer and in response initiate obtaining the biometric information of the customer, Walker teaches that the machine can accept cash-oriented credit from customers in his patent (abstract and figs). Therefore in view of walker, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a credit-accepting mechanism to accept cash-oriented credit from the customer for convenience and ease of payment options.

Response to Arguments

5. Applicant's arguments filed on 3/17/2007 have been fully considered but they are not persuasive.

Applicant's argument in regards to claims 1-7 under 35 U.S.C. 112 1st paragraph, due to lack of enablement has been fully considered but they are not persuasive. In response to applicant's argument that the claims would allow one of the ordinary skill in the art to understand. It is noted that the specification on page 4, 14-17 states the database preferably does not include biometric information of the customer him or herself. However such claim limitation are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, how would the computer distinguish between a celebrity who is also a customer / player of such invention, if Brad Pitt or Jennifer Aniston wants to play the entertainment system, how would the machine eliminate Brad Pitt or Jennifer Aniston from the searchable database.

Applicant's arguments with respect to claims 1, 2, and 4-6 rejected under USC 102(b) by Ort (5,659,626) have been considered but are moot in view of the new ground(s) of rejection. The 102(b) rejection by Ort has been withdrawn.

In response to applicant's argument that claims 1 and 8 are limited to an "entertainment machine." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In response to the applicant's argument that the applicant

Art Unit: 3714

submitted amendment of claimed invention is limited to comparing the biometric information of the customer to a database of biometric information of predetermined people “with which the customer is likely to be familiar.” The applicant cannot make argument to subject matters not claimed. Applicant’s amended claims and argument have been addressed in the rejection, the arguments has been considered but are moot.

6. In response to applicant’s argument to claims 13 and 18 that Howard is silent in terms of anticipation to claims 13 and 18, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. As stated such in ¶ 22 -23, the IDENTIX FACE IT product has the ability to compare two facial images or fingerprint images and determine the similarities between the two. In regards to the argument that by comparing the two images or fingerprints the customer/players are not informed, rather the law enforcement are informed of such result. It is a mere choice to who is informed of such result, it does not constitute a distinct patentable limitation. Once again, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, which it is, then it meets the claim. Further in response to the applicant’s argument that Howard does not disclose indicating how closely the biometric information of the first and the second customer match one another to these customers themselves. Again applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define

Art Unit: 3714

a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Howard is not silent in regards to this feature, as disclosed by Howard; there exists a face score indicating a degree of match to the probe image (§ 125). It is also stated that the threshold might be set to be all results having a face score of 75 or greater. Clearly Howard is not silent as to this point.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kang Hu whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

Art Unit: 3714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KH/
Kang Hu
May 29, 2007


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